

**REMARKS**

Claims **1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36** and **38-45** are pending in the application.

Claims **1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36** and **38-45** stand rejected.

Claims **1, 3, 4, 7, 9, 11-18, 20, 26, 31, 36** and **41-42** have been amended . No new matter is added hereby. The present claim amendments find support throughout the Specification, including at paragraphs [0050] and [0071]-[0072], and Figs. 4 and 8, for example. Applicants assert that the present claim amendments should not be construed as indicating Applicants' acceptance of the reasons for rejection presented in the Office Action.

After present claim amendments, claims **1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36** and **38-45** remain pending in the application.

*Comments on Official Notice taken in the Office Action of August 28, 2008*

It is posited in present Office Action that Applicants have somehow failed to properly traverse the Official Notice taken in the previous Office Action (dated August 28, 2008; "Previous Action"). (*See*, Office Action, item-5 on page-3.) However, Applicants respectfully assert that no need to specifically traverse such Official Notice, either at that time or presently, because the facts noticed therein did not relate to the claim limitations discussed in reference to the patentability of claims 9, 12-14, and 17 under 35 U.S.C. § 103(a). Applicants respectfully submit that the irrelevance of the Official Notice to these limitations was noted in their response thereto. (*See*, discussion on page-19 in Applicants' response to the Previous Action.) Therefore, Applicants respectfully disagree with the characterization of the facts noticed in that Official Notice as "admitted prior art." *Id.* Applicants maintain that such Official Notice continues to be irrelevant and Applicants' traversal thereof unnecessary. Hence, the issue of the status of the

noticed facts—whether “admitted prior art” or not—is neither relevant nor appropriate at this juncture, given the instant case’s current procedural posture.

*Defects in the Office Action*

Applicants respectfully note three significant defects in the present Office Action and respectfully request these issues be addressed in the next Office communication.

(i) First, it is observed that the present Office Action continues to argue against the patentability of claims 2, 6, and 10, which were cancelled previously (and continue to be so). (*See*, Office Action, discussion on pages 9-10.) In view of prior cancellation of claims 2, 6, and 10, Applicants respectfully submit that response to such rejection is unnecessary.

(ii) Second, Applicants respectfully observe that the Office Action fails to provide any detailed reasoning for rejection of claims 20, 22-26, 28-31, 33-36, and 38-40. Although a similar omission was present in the Previous Action, Applicants treated it as an oversight and simply responded to the rejections present therein. However, recurrence of the situation in the current Office Action raises concerns as to the propriety and validity of the rejection of these claims thereby. In any event, despite such defects in the present Office Action and merely to expedite prosecution, Applicants continue to argue the patentability of claims 20, 22-26, 28-31, 33-36, and 38-40 in the same manner as had been done in their earlier response.

(ii) Third, Applicants are at a loss to understand the identity and content of the “Flores” reference referred to in the Office Action, in rejecting claims 8, 15, and 16. (*See*, Office Action, discussion on pages 10-11.) Although a similar error existed in the Previous Action, Applicants treated it as a typographical error, assuming that “Flores” was intended to refer to “Diaz.” Therefore, Applicants’ response to the Previous Action argued patentability of claims 8,

15, and 16 over Diaz, and not over “Flores.” However, the present Office Action continues to refer to “Flores” in rejecting claims 8, 15, and 16. Furthermore, the reference to “Flores” is interspersed between references to “Diaz,” which now leads Applicants to believe that the term “Flores” is not a typographical error, but rather that two distinct references—Flores and Diaz—exist and are being cited. If this assumption is correct, Applicants respectfully request that the intended reference be properly identified, so that Applicants can respond meaningfully to the rejections. However, in order to expedite prosecution of the instant matter, Applicants continue to argue the patentability of claims 8, 15, and 16 over Diaz, as in their earlier response.

*Rejection of Claims under 35 U.S.C. §101*

Claims 1, 3-5, 7-9, 11-19, 41, and 42 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Without acceding to the Office Action’s reasons for rejecting these claims, Applicants have amended claims 1, 3, 4, 7, 9, 11-18, and 41-42 to more clearly recite that the methods claimed therein are computer-implemented methods and that various method steps recited in these claims are performed using a processor of that computer system. In view of these amendments, Applicants respectfully submit the amendment of dependent claims 5, 8, and 19 is unnecessary. Applicants therefore respectfully request the withdrawal of rejection of claims 1, 3-5, 7-9, 11-19, 41, and 42 under 35 U.S.C. § 101 and allowance thereof

*Rejection of Claims under 35 U.S.C. §112*

Claims 41-45 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 41-45 are also rejected under 35 U.S.C. §112,

first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse these rejections as follows.

(I) The Written Description Rejection

In rejecting claims 41-45 for failing to comply with the written description requirement, the Office Action states that paragraphs 30 and 65-68 in the specification “do not mention these actions at all” and, therefore, “the newly added limitations [in claims 41-45] are new matter.” (*See*, Office Action, discussion under item-9.) Applicants point out that the paragraphs 30 and 65-68 were mentioned in Applicants’ response to the Previous Action by way of examples, and not in any rigidly restrictive or limiting manner. (*See*, page-13 in Applicants’ response to the Previous Action.) In any event, Applicants point out, again by way of examples and not in any limiting manner, specific portions in the instant specification where the “transforming”, “creating”, “comparing”, and “determining” steps in claims 41-45 are described in such a way as to reasonably convey to one skilled in the relevant art that Applicants, at the time the application was filed, had possession of the claimed invention.

The “transforming” step is described, for example, in paragraph [0066] read in conjunction with paragraphs [0028] and [0029]. The “creating” step is described, for example, in paragraphs [0067]-[0068] and depicted at processing block 710 in Fig. 7 in the instant specification. The “comparing” step is described, for example, in paragraph [0068]. And, the “determining” step is described, for example, through paragraphs [0030], [0041], and [0068].

Based on the foregoing, Applicants respectfully submit that claims 41-45 satisfy the written description requirement and, hence, respectfully request the withdrawal of this rejection.

(II) The Enablement Rejection

Applicants assert that the Office Action has failed to establish a *prima facie* case of lack of enablement as discussed in more detail below. In rejecting claims 41-45 under 35 U.S.C. § 112, first paragraph, the Office Action argues that “the claims and specification do not provide any particular structure or method by which to perform these [recited] steps.” (*See*, Office Action, discussion under item-10.) In response, Applicants begin with a quote from MPEP § 2164 that “[d]etailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention.” Applicants assert that the subject matter recited in claims 41-45, when read in conjunction with the instant specification, clearly enables one skilled in the art to practice the claimed subject matter. Applicants point out that MPEP § 2164.08 also provides that:

Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. *See, e.g., In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

(Emphasis added.)

Similarly, MPEP § 2164.03 provides that, “The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. ...The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification.” (Emphasis added.)

Thus, Applicants assert that the subject matter recited in claims 41-45 is properly enabled when interpreted in conjunction with the description in the instant specification and what is known to one skilled in the relevant art.

Applicants observe that nowhere in the Office Action is there presented a discussion of enablement that quotes the relevant standard. MPEP § 2164.01 provides that:

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.

(Emphases added.)

In other words, in leaping to a conclusion of non-enablement, the Office Action not only fails to mention "undue experimentation," but also completely omits any evaluation of a number factors provided under MPEP § 2164.01(a), a portion of which is reproduced below:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

(A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

...

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors,

and any conclusion of nonenablement must be based on the evidence as a whole.  
[Citation omitted.]

...

The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations.

(Emphases added.)

Applicants respectfully submit that the present Office Action's silence with regard to evaluation of the above-mentioned factors renders the Office Action's conclusion of non-enablement improper and unsupportable based on current caselaw and the MPEP. In view thereof, Applicants defer the provision of any additional evidence of enablement of claims 41-45.

In light of the foregoing discussion, Applicants assert that a *prima facie* case of non-enablement is not established consistent with the guidelines provided in the MPEP. Applicants reiterate that, "To establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation." (MPEP § 2164.06(c)) (Emphases added.) Hence, Applicants respectfully request the withdrawal of this non-enablement rejection.

*Rejection of Claims under 35 U.S.C. §103*

Claims 1-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Juan Sanchez Diaz et al., "From User Requirements to User Interfaces: A Methodological Approach,"

13<sup>th</sup> Int. Conf., CAiSE 2001, in 2068 Lecture Notes in Comp. Sci. 60 (K.R. Dittrich, et al., eds., Springer-Verlag, June 4-8, 2001) (“Diaz”) in view of Official Notice.

Claims 2, 6, 10, 21, 27, 32, and 37 were cancelled prior to the current Office Action, and so the rejection of these claims is moot.

Applicants respectfully traverse the § 103(a) rejection of remaining pending claims 1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36, and 38-40 in view of the following remarks and present claim amendments.

Applicants initially observe that Diaz already has been applied to the immediately-previous version of the pending claims in the present application. Therefore, Applicants hereby incorporate all discussions related to the patentability of pending claims 1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36, and 38-40 in view of Diaz at least as presented in Applicants’ response (“Previous Response”) to the Previous Action of August 28, 2008, to the extent that those arguments are relevant to limitations in the currently pending claims. Furthermore, Applicants also incorporate herein their discussion of Diaz as provided in the Previous Response and do not repeat such discussion herein for the sake of brevity.

While not conceding that the cited reference qualifies as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows, in light of the amendments made hereby. Applicants reserve the right, for example, in a continuing application to establish that the cited reference, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

## PATENT

In order for a claim to be rendered unpatentable under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). Thus, when making a determination of obviousness, the focus should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. MPEP § 2141.

Applicants respectfully maintain that the combination of Diaz and Official Notice fails to show, teach or suggest the limitations of independent claims 1, 9, 20, 26, 31, and 36 as discussed in more detail below. Because each of the pending independent claims 1, 9, 20, 26, 31, and 36 has been amended to recite comparable limitations, in the discussion below, claim 1 is treated as representative of other independent claims.

**Applicants respectfully assert that the Office Action has failed to establish a *prima facie* case of obviousness of independent claims, at least by reason of the Official Notice taken therein being defective.** Applicants initially note that although the independent claims have been amended in the present response, the amendments are made simply to clarify that (i) a “view” of a business process is presented as an electronic image representing a user interface defined by the application product, and (ii) the business process and its associated views are simultaneously displayed within a single user interface displayed on an electronic display. In other words, the present claim amendments simply provide further clarification in support of Applicants’ assertion that Diaz fails to show, teach or suggest the simultaneous display of a business process model and its associated views within a single user interface displayed on an

electronic display, wherein each view is an electronic image representing a user interface defined by the application product, as recited more fully in amended independent claim 1. As mentioned in the Previous Response, all displays of use case models, state transition diagrams, message sequence charts, or user interface forms shown and discussed in Diaz are stand-alone, individual displays. (*See*, Diaz, Figs. 1-4 and 5-9.)

Because of the clarifying nature of the present claim amendments, Applicants assert that the following two points in the Office Action also remain applicable to the present set of independent claims: (i) the Office Action's acknowledgment that Diaz fails to disclose "simultaneously displaying the business process model and the plurality of views on a display," and (ii) the Office Action's reliance on the Official Notice that "it is old and well known to display a model and a corresponding view at the same time." (*See*, Office Action, discussion under item-12 at the bottom of page-7.) In view of the acknowledged deficiencies of Diaz, Applicants focus only on the deficiencies in the Official Notice in the discussion below.

**(A) Defects in Official Notice of "storyboarding"**

The Office Action mistakenly alleges that several previously-mentioned references (although not cited against any pending claims) teach "storyboarding," where "a description of a scene or action is placed beside a mockup of an artist's depiction of what the scene or action is intended to look like." (*See*, Office Action, discussion under item-12 at the bottom of page-7 and top of page-8.) Although, for the sake of brevity, Applicants discuss only the Lin reference herein (James Lin et al., "DENIM: Finding a Tighter Fit Between Tools and Practice for Web Site Design," CHI Letters, Vol. 2, issue 1, p. 510 (1-6 April 2000)), Applicants assert that none of the storyboarding-related references mentioned in the Previous Office Action show, teach or suggest the simultaneous display of a business process model and its associated views within a

single user interface displayed on an electronic display, wherein each view presents an electronic image representing a user interface defined by an application product, as recited more fully in amended independent claim 1.

In case of Lin, none of the DENIM user interfaces shown therein (*i.e.*, Figures 1 and 4 in Lin) simultaneously displays a business process model (or a website map) and its associated views within a single user interface, as recited more fully in amended independent claim 1. In Lin, the “site maps” in Figure 2 represent “an entire web site at a coarse granularity, where the smallest unit represented is a page or a related group of pages,” whereas, at a finer level of granularity, the “storyboards” in Figure 3 “represent specific interaction sequences, such as how a user might execute a task using a part of the site.” (Lin, page 511.) Thus, in Lin, neither a “site map” nor a “storyboard” is an electronic image representing a user interface as required by claim 1. Furthermore, Lin mentions on page 514 therein that, “In run mode, a simplified ‘browser’ window appears on the screen. The browser displays one page at a time, like a real web browser, except the pages displayed are the sketches that the designer has created. If an element inside a page is the source of a navigational link...[c]licking on these elements causes the browser to display the target of the link, just as in a conventional browser.” (Emphases added.) Thus, there is no showing, teaching or suggestion in Lin of any simultaneous display of a site map along with its associated electronic target images (not mere designer sketches) within a single user interface displayed on an electronic display.

The zoom slider in Fig. 5 in Lin clearly demonstrates the sequential, non-simultaneous nature of various stages of displays that Lin intends to be used in its approach. Furthermore, Figure 4 in Lin also depicts how the zoom level of the content depicted in the user interface can be changed by selecting an icon on the left-hand pane of a user interface in the DENIM web-

design tool changes. As is clear from Figures 4 and 5 and related discussion in Lin, such actions and constructs cannot be reasonably understood to refer to an “electronic image” representing a user interface.

Thus, Applicants assert that the Official Notice of “storyboarding” references as teaching the simultaneous display aspect of pending independent claims not only suffers from a number of infirmities, but clearly demonstrates a cognitive leap unsupported by the teachings in those references.

**(B) Defects in Official Notice related to Homrighausen**

The Office Action next refers to Figure 5 in Homrighausen (Andreas Homrighausen et al., “Round-Trip Prototyping Based on Integrated Functional and User Interface Requirements Specifications,” 7 Requirements Engineering 34 (2002)), and posits that the figure shows “an activity graph...presented with a corresponding ‘scene’.” (See, Office Action, discussion on page-8.) The Office Action further posits that the “scene” in Homrighausen “provides an image of what the user is presented with.” *Id.* Applicants respectfully disagree.

In the User Interface Analysis (UIA) method of Homrighausen, a “scene” is a fundamental UIA element “comprising class views and user operations. Scenes together with their relationships and class views determine the static structure of the user interface. The scene concept provides for a homogeneous decomposition of a user interface into its main building blocks.” (Homrighausen, page-37, first paragraph under section 3.1.) (Emphases added.) In the same section 3.1, Homrighausen further states that, “A scene may comprise class views. A class view is...an abstract presentation of (properties of) instances and associations of a domain class...A class view abstracts from actual user interface details.” (Emphases added.) Thus, in view of clear distinctions in Homrighausen between an “actual user interface” and its “abstract

presentation” (via a class view), Applicants assert that a “scene” in Homrighausen is just a building block of a user interface (*see*, e.g., Table-1 on page-38 in Homrighausen) and so cannot be reasonably interpreted as teaching an electronic image of a user interface. Such a misinterpretation of Homrighausen’s teachings related to a “scene” results in further infirmities of the Official Notice taken. Furthermore, none of the screenshots of user interfaces in Homrighausen (*i.e.*, Figures 8, 9, 11, and 12) shows, teaches or suggests the simultaneous display of a UID (User Interface Design) model along with electronic images of its associated user interfaces within a single user interface displayed on an electronic display, as recited more fully in amended independent claim 1.

Applicants therefore respectfully assert that the teachings in Homrighausen fail to reasonably show, teach or suggest, among other limitations, the simultaneous display aspect of pending independent claims without any hindsight bias. Thus, the Official Notice based on Homrighausen for the teaching simultaneous display aspect not only suffers from a number of infirmities, but clearly demonstrates a cognitive leap unsupported by the teachings in Homrighausen (or any reasonable extrapolation thereof).

**(C) Defects in Official Notice related to Nunes & Cunha**

Finally, the Official Notice attempts to find a basis in Nunes & Cunha (Nuno J. Nunes & Joao F. Cunha, “Wisdom - Whitewater Interactive System Development with Object Models,” Version 4.0, 21 April 2000) for teachings related to “dialogs” being “images of a user interface.” (*See*, Office Action, discussion on page-8.) The Official Notice then refers to Figs. 6 and 7 in Nunes & Cunha as providing a “simultaneous display” of an analysis model and a presentation and dialogue model, and to Fig. 17 therein as providing “an actual screenshot of this methodology.” *Id.* Applicants again respectfully disagree.

Applicants respectfully note that Nunes & Cunha (at p. 13) clearly states that “dialogue models are fundamental models in user interface design...The Wisdom dialogue model serves this purpose while...ensuring the separation of concerns between the user interface and the functional core, and also between the presentation and dialogue aspects of the system.” (Emphases added.) The context of discussion in Nunes & Cunha, along with its recognition of distinctions between presentation and dialogue aspects in a user interface design, leads one to reasonably conclude that a “dialog” in Nunes & Cunha is in fact not an electronic image of a user interface, but instead simply a building block of a user interface. Furthermore, it is clear from Fig. 6 in Nunes & Cunha that neither the analysis model nor the interaction model depicted therein has any semblance of an electronic image of a user interface. Rather, the models of Fig. 6 represent “information spaces” for the Wisdom interaction architecture. (Nunes & Cunha, page 14/37.) On the other hand, Fig. 7 in Nunes & Cunha “represents the four software development workflows and the corresponding Wisdom activities, models, and diagrams used to specify the models.” (Nunes & Cunha, page 17/37.) Thus, Fig. 7 in Nunes & Cunha merely represents a process flow and fails to show, teach or suggest any simultaneous display of a software development model along with electronic images of its associated user interfaces within a single user interface displayed on an electronic display, as recited more fully in amended independent claim 1.

Figure 17 in Nunes & Cunha “illustrates the process of mapping descriptions from the Bridge participatory sessions into the Wisdom model based approach and the concrete user interface...This mapping clearly shows the role of Wisdom views realising the interface architecture. The final step in this process would be to execute the Bridge part 3 to map the Wisdom views into concrete GUI objects.” (Nunes & Cunha, page 33/37.) Again, it is evident

from the screenshots in Fig. 17 of Nunes & Cunha that the mapping depicted in Fig. 17 merely results in individual presentations of object attributes, data, or other information in corresponding GUIs, and does not result in any sort of simultaneous display of a software development model along with electronic images of its associated user interfaces within a single user interface displayed on an electronic display, as recited more fully in amended independent claim 1.

Hence, Nunes & Cunha also fails to show, teach or suggest the simultaneous display aspect recited more fully in amended independent claim 1. In view of such deficiencies in teachings in Nunes & Cunha, Applicants respectfully assert that the Official Notice of Nunes & Cunha with regard to such simultaneous display not only suffers from a number of infirmities, but clearly demonstrates a cognitive leap unsupported by the teachings of Nunes & Cunha (or any reasonable extrapolation thereof).

**From the foregoing discussion, Applicants assert that the Official Notice taken in the present Office Action suffers from a number of infirmities, and so results in a failure to establish a *prima facie* case of obviousness of the independent claims.** Applicants therefore assert that Diaz in view thereof continues to fail to show, teach or suggest the simultaneous display of a business process model and its associated views within a single user interface displayed on an electronic display, wherein each view is an electronic image representing a user interface defined by the application product, as recited more fully in each of the amended independent claims.

Because independent claims 9, 20, 26, 31, and 36 recite limitations comparable to those discussed hereinbefore with reference to independent claim 1, Applicants assert that each of the pending independent claims 1, 9, 20, 26, 31, and 36, as a whole, is not rendered obvious under

35 U.S.C. §103(a) by Diaz in view of the Official Notice, for at least the foregoing reasons.

Without acceding to the Examiner's reasons for rejection of various dependent claims and reserving their right to proffer additional evidence of patentability of dependent claims, as necessary, Applicants assert that dependent claims 3-5, 7-8, 11-19, 22-25, 28-30, 33-35, and 38-40 are also patentable over Diaz in view of the Official Notice taken, for at least the foregoing reasons. Reconsideration and allowance of claims 1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36, and 38-40 is therefore respectfully requested.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5084.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicants hereby petition for such extensions. Applicants also hereby authorize that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,

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